

REMARKS

Claims 17-19 and 23-27 are pending in the Application. No claim has been amended herein.

The claims stand variously rejected. Each rejection is respectfully traversed as discussed below. Applicants respectfully submit that the claims are in condition for allowance and earnestly solicit notification to that effect.

Request for clarification regarding prior rejections

The Office Action mailed August 11, 2004 included an objection to the Abstract and a rejection of claim 26 under 35 USC §112, first paragraph, as indefinite. Applicants addressed these rejections in the Response filed December 9, 2004. The Examiner did not indicate in the current Office Action that the rejections were withdrawn, but also did not repeat the rejections. Accordingly, Applicants respectfully request that the Examiner withdraw these rejections and notify Applicants of the same.

Rejections under 35 U.S.C. § 112, Second paragraph

In the Office Action, claims 17-19 and 23-25 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for reciting "at least 2" in the definition of a and b. Applicants respectfully traverse the rejection.

Open ended ranges are not *per se* indefinite. See, e.g., *In re Kirsch*, 498 F.2d 1389, 1394 (CCPA 1974) (only maximum limit specified; claim not indefinite). The Examiner's attention is respectfully directed to MPEP 2173.05(c), which states that open-ended numerical ranges should be carefully analyzed for definiteness. The Examiner has not provided *any* reasoning to support the rejection and therefore has not established that the presently pending claims are indefinite. Thus, it is respectfully asserted that the burden has not been shifted to Applicants. Accordingly, withdrawal of the rejection is requested.

Rejections under 35 U.S.C. § 112, First paragraph

In the Office Action, claims 26 and 27 were rejected as allegedly failing to comply with the enablement requirement. Applicants respectfully traverse the rejection.

The Office Action indicates that the claims encompass treating any multidrug resistance and inhibiting transport protein activity. The Office Action further indicates that the only diseases described in the specification are cancer and HIV. The Office Action states that Applicants have not provided examples regarding treatment of multidrug resistance or inhibition

of transport protein activity. The Office Action states that the only measure of treating multidrug resistance is treatment of a disease in a mammal and that Applicants have not indicated the disease in the claim.

As an initial matter, Applicants note that the Examiner has not addressed Applicants' arguments in the Response filed December 9, 2004. In this regard, the MPEP instructs:

Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it. MPEP 707.07(f).

Applicants therefore respectfully request that the Examiner address Applicants' previous Response. In particular, Applicants have argued that claim 26 is fully enabled, as evidenced by the allowance of claims 17 and 18 in the parent case, which issued as U.S. Patent 6,376,514. Issued patents are presumed to be valid. 35 U.S.C. § 282. Applicants respectfully assert that the Examiner has not carried the Office's burden of establishing nonenablement with respect to the rejected claims.

Contrary to the Examiner's assertion that "[t]he applicants have not given an example[] o[f] how it does treat the multidrug resistance or inhibit [transport] protein activity," Applicants have indeed demonstrated abrogation of multidrug resistance in the present specification. The Examiner is directed to Reference Examples 1-4 on pages 29-30 and Example 85 on pages 72-74. Examples 1-4 provide the skilled artisan with *in vitro* experiments which can be used to measure inhibition of transport proteins Pgp and MDR1. Example 85 provides results obtained in experiments conducted in accordance with Examples 3 and 4 using several compounds presently claimed. As shown in Table 3 at pages 73-74, cells treated with the compounds of the invention retained from 5 to 13 times the amount of fluorescently-tagged taxol as did untreated cells. A number of the compounds also exhibited inhibition of MDR1 in the substrate potential assay.

The Examiner has also stated that Applicants have not provided guidance in treating any diseases. However, Applicants have not *claimed* treating diseases. Applicants have claimed treating multidrug resistance and inhibiting transport activity with the claimed compounds. Ample guidance is provided in the specification with respect to these claimed methods, as argued above.

Claim 27 is more particularly drawn to inhibiting transport protein activity comprising contacting cells with the composition of claim 25. Applicants respectfully assert that because claim 26 is enabled (as argued above), *a fortiori*, claim 27 is also enabled, particularly in light of the teaching of the Examples 1-4 and 85. Allowance of claim 27 is also respectfully requested.

Accordingly, Applicants respectfully assert that claims 26 and 27 are fully enabled by the present specification and earnestly solicit notification to that effect.

CONCLUSION

Based on the foregoing, Applicants respectfully submit that the present application is in condition for allowance, and a favorable action thereon is respectfully requested. Should the Examiner feel that any other point requires consideration or that the form of the claims can be improved, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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